

Application No. 10/765,355

REMARKS

With regard to the rejection of Claims 2, 23 and 34 under 35 U.S.C. 112, which rejections are traversed, especially since the claims are to be interpreted by one of ordinary skill in the art, Applicants have clarified Claim 2 by deleting the phrase "an optional". With regard to Claim 23, it is believed that this claim is in a proper format, and that it indicates generating an image. Applicants believe that there is no basis for the Examiner's position that how the image is generated specifically needs to be recited.

Concerning Claim 34, that claim has been clarified as indicated.

The rejection of Claims 1 to 34 under 35 U.S.C. 102(a) as being anticipated by U.S. Patent 6,656,650 is respectfully traversed.

The Examiner's comments and specific references to, for example, column 11, lines 5 to 15; column 12, line 45; column 11, lines 25 to 55, have been reviewed, and it is not believed that the Examiner has established a *prima facie* case of obviousness.

A review of the '650 patent clearly indicates that there is contained in the charge transport layer charge transport molecules and a polytetrafluoroethylene. The importance of the polytetrafluoroethylene is indicated in the disclosure of the patent, and more specifically, in Table 1, wherein an imaging member was fabricated without the polytetrafluoroethylene. As the Examiner appreciates, for a 102(a) rejection to be sustainable the Examiner must point out each and every feature of the claimed invention in the reference being applied. The Examiner has not accomplished this in view of the presence of the polytetrafluoroethylene in the '650 patent.

Concerning the rejection of Claims 1 to 34 under the judicially created doctrine of obvious type double patenting as being unpatentable over Claims 1 to 55 of U.S. Publication 20040197685, U.S. Application No. 10/408,204 (Attorney Docket A2147-US-NP) in view of some secondary

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references, Applicants traverse this rejection. Nevertheless, to expedite prosecution, Applicants are submitting herewith a Terminal Disclaimer whereby any patent issuing from the present application will expire simultaneously with any patent resulting from the copending application Publication No. 20040197685.

Concerning the provisional rejection of Claim 19 and Claim 1 under the judicially created doctrine of double patenting over Claim 1 of copending Xerox Application No. 10/347,231, not 10/347,321 which is not a Xerox Application, and Xerox Application No. 10/300,643 (now US Patent 6,946,227), this rejection is traversed as the Examiner has not provided sufficient basis that each component of the rejected claims are recited in the copending claims.

Whether or not Applicants could have included claims in the copending applications to the present invention is not a basis for a rejection in Applicants' view since such claims were not included in the copending applications.

Accordingly, it is respectfully urged that the Examiner reconsider his positions and issue a Notice of Allowance.

No additional fee is believed to be required for this amendment, however, the undersigned Xerox Corporation attorney (or agent) hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025.

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In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby requested to call Eugene O. Palazzo, at Telephone Number 585-423-4687, Rochester, New York.

Respectfully submitted,



Eugene O. Palazzo
Attorney for Applicant(s)
Registration No. 20,881
(585) 423-4687

EOP/jah

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Xerox Corporation
Xerox Square 20A
Rochester, New York 14644